

REMARKS

Claims 9 and 21-22 are pending in the present application. Claims 9 and 21-22 are amended herein. Claims 18 and 28 are cancelled herein and claims 1-8, 10-17, 19-20 and 23-27 were previously cancelled.

Objections to the claims

Claim 9 has been objected to for the reasons noted on pages 2 and 3 of the Office Action. Claim 9 has been amended to address the objections. As such, withdrawal of the objections is respectfully requested.

Obviousness-type double patenting rejection

The Examiner maintains the obviousness-type double patenting rejection of claims 9, 18, 21, 22 and 28 as being unpatentable in view of claims 59 and 60 of co-pending application No. 10/622,377. Applicants request that this rejection be held in abeyance until the claims in one of the two application are otherwise allowable, since the rejection is, at this time, provisional.

Rejections under 35 USC § 102

Claims 9, 18, 21, 22 and 28 remain rejected under 35 U.S.C. 102(c) as being anticipated by Maher et al. (US Patent 6,686,193 B2). Applicants traverse this rejection and withdrawal thereof is respectfully requested.

In maintaining the rejection, the Examiner takes the position as stated on page 6, first paragraph, of the Office Action that the phrase ““expressed in osteoclasts” does not limit the cell type used in the claimed method.” Applicants respectfully note that the recited limitation “expressed in osteoclasts” does not refer to the test cell in which the channel is expressed in the screening assay, but rather is the type of cell from which the C1C-7 channel that is used in the assay is derived. Thus, the claimed method requires the use of the C1C-7 channel that is from

osteoclasts, but the channel does not need to be expressed in an osteoclast in the assay and can be recombinantly expressed in another cell type for the screening assay. The presently claimed method is thusly limited to a specific CIC-7 channel, i.e. the CIC-7 originating from osteoclasts.

The Examiner further states, in maintaining the rejection, that the phrase “wherein the screening method identifies compounds having potential activity in treating osteoporosis, osteolytic cancer invasion or Paget’s disease of the bone” does not limit the practiced method steps of the claim. Claim 9 has been amended to actively recite the feature that is required to fully identify compounds having potential activity in treating the recited diseases. Thus, the passive feature of “wherein the screening method identifies compounds having potential activity in treating osteoporosis, osteolytic cancer invasion, or Paget’s disease of bone” has been recited as an active step of further measuring the efficacy of any chemical compound, which is identified as having the ability to block the CIC-7 chloride channel, in treating osteoporosis, osteolytic cancer invasion, or Paget’s disease of bone. This step would be readily understood by one skilled in the art to be a necessary part of the claimed assay of identifying compounds having potential to treat osteoporosis, osteolytic cancer invasion, or Paget’s disease of bone. Thus, it is not new matter to recite this active step.

There is no disclosure or suggestion in Maher et al. of either

- 1) specifically using an osteoclast-derived CIC-7 channel in a screening assay; or
- 2) identifying compounds that specifically have efficacy in treating osteoporosis, osteolytic cancer invasion, or Paget’s disease of bone.

As such, the claimed invention is neither anticipated by nor obvious over Maher et al. and withdrawal of the rejection is respectfully requested.

In view of the above amendments and Remarks, Applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact MaryAnne Armstrong, Ph.D., Reg. No. 40,069 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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